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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/501,135

07/13/2004

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4865-13

7877

23117 7590 08/28/2008  
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EXAMINER

YOUNG, SHAWQUA

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

08/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/501,135	<b>Applicant(s)</b> GIANNESI ET AL.	
	<b>Examiner</b> SHAWQUIA YOUNG	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11 and 12 is/are rejected.
- 7) ☒ Claim(s) 1, 9 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/7/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 1-5, 7 and 9-12 are currently pending in the instant application. The Examiner has withdrawn the finality of the previous Office Action mailed on May 28, 2008 because prior art has been found. Further, any indication that the pending claims were allowable has been withdrawn.

#### **I. *Response to Arguments***

Applicant's amendment, filed August 7, 2008, has overcome the rejection of claims 8 and 9 under 35 USC 112, first paragraph for scope of enablement. This rejection has been withdrawn.

The Examiner has found prior art that anticipates genus compound of formula I and will be discussed in further detail below.

#### **II. *Information Disclosure Statement***

The information disclosure statement (IDS) submitted on August 7, 2008 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

#### **III. *Rejection(s)***

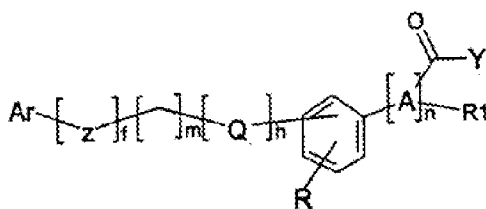
**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 5 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by *Crandall, et al.* (See RN 24220-48-2, CAPLUS). The instant invention claims a



product with the formula

wherein **A** is CH,

alkanylidene with 2 to 4 carbon atoms or alkenylidene with 2 to 4 carbon atoms; **Ar** is phenyl optionally substituted by halogens, NO<sub>2</sub>, OH, C<sub>1-4</sub> alkyl and alkoxy, said alkyl and alkoxy optionally substituted by at least one halogen; **f** is the number 0 or 1; **h** is the number 0 or 1; **m** is a whole number from 0 to 3; **n** is the number 0 or 1 and if **n** is 0, **R<sub>1</sub>** is absent and COY is directly bound to benzene; **Q** is oxygen; **Z** is as defined in claim 1; **R** is selected from **R<sub>2</sub>** and OR<sub>2</sub>; **R<sub>1</sub>** is as defined in claim 1; and all other variables are as defined in claim 1.

The *Crandall, et al.* reference teaches the compound [4-(phenylmethoxy)phenyl] diethyl ester propanedioic acid (See RN 24220-48-2, CAPLUS). This species of compound anticipates the genus compound of the instant invention, wherein the genus structure and its definitions are stated above.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 recites the limitation “Ar is a heteroaryl” which is dependent on claim 1 but the group heteroaryl is not found in the definition of variable Ar in claim 1. There is insufficient antecedent basis for this limitation in the claim. Claim 3 recites the limitation “Ar is an aryl” which is dependent on claim 1 but the group aryl is not found in the definition of variable Ar in claim 1. There is insufficient antecedent basis for this limitation in the claim. Claim 11 recites the limitation “the heteroatom in the heteroalkyl” which is dependent on claim 1 but the group heteroalkyl is not found in the definition of any variables in claim 1. There is insufficient antecedent basis for this limitation in the claim.

**IV. *Objections***

***Dependent Claim Objections***

Dependent Claims 7, 9 and 11 are also objected to as being dependent upon a rejected based claim.

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**V. Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 7:00 AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Shawquia Young/

Examiner, Art Unit 1626

/Kamal A Saeed, Ph.D./

Primary Examiner, Art Unit 1626